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EXAMINER

TRINH, MINH N

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 11/04/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/061,688

Applicant(s)

REGALA ET AL.

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on phone interview dated 10/29/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicants' election without traverse of Group I, claims 1-17 in Paper No. 6 is acknowledged. However, claims 1-17, further restricted to Group A (claims 1-14) and Group B (claims 15-17) as described in prior Office Action (in paragraph 2), and applicants' election of group A (claims 1-14) and cancel Group B (claim 15-17) as the result of a phone interview (see Interview summary, dated 10/29/03).

2. Applicants' election of Group A, claims 1-14 and cancellation of Group B, claims 15-17 is acknowledged (see interview summary). Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). An Office Action on the merits of claims 1-14 follows:

### ***Specification***

3. The specification is objected to because it is inconsistent with the claim languages the following are examples: the specification discloses an upper and a lower degater halves (see page 6, paragraph 0020) and the claims recites a first and a second degater halves (see claim 1, lines 2). Applicants should be careful review the claims and the specification and make the claims languages consistent with what describes in their specification.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example: the limitation: "a separator secured to the first half and having a first surface contacting a second of the subassemblies," was insufficiently described in the specification and/or the drawings in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:

The preamble of the claims directed to a degater however the body of the claims are directed to the outside element such as: a subassembly including a first electronic component having an encapsulant formed thereon, (see claim 1,

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lines 5-9) and define the degater relative to the outside structure. Therefore, it is not clear if applicant is solely relying on the degater for patentability or if applicant is relying on the degater in combination with the subassemblies for patentability. If applicant indicated by amendment that the combination of the socket and a board is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the degater alone, then the body of the claims must be amended to remove positive recitation of the combination.

It is unclear whether "a subassembly" (claim 1, line 8) is the same as "a assembly" as previously recited in claim 1, line 8.

"the subassemblies" (claim 1, line 10 and 12) lack proper antecedent basis. Also it is not know whether "the subassemblies " is the same as "a

It is also not know what is being referring to as: "a first of the subassembly" (see claim 1, line 12); "the first subassembly" (claim 1, line 12) and whether they are the same.

It is also not know what is being referring to as: "a second of the subassembly" (see claim 1, line 15-16); "the second subassembly" (claim 1, line 17-18) and whether they are the same.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-12 and 14, as best understood are rejected under 35

U.S.C. 102(b) as being anticipated by Kuno et al (US 5,753,538).

Kuno et al disclose an apparatus for molding (= a degater) of the present invention comprising: a first and second mold halves 1, 2 which are movable relatively to one another between a first position (closed) and a second position (opened) as described in figures 1-2; a retainer 17 having a first portion secured to the first half and a second portion for securing the associated subassembly (electronic assembly 14, see Fig. 5A); a separator (pin 11) secured to the first half 1 and having a first surface (bottom surface) for contacting at least part of the electronic assembly 14 (see Figs. 1-3, and the discussion at col. 7, lines 1-37).

Note that because the present invention does not define what exactly is the claimed "a separator" and it appears the feature 11 of Fig. 3 of Kuno et al is readable on "a separator" of the present invention. Also, with respect to the limitation recites: "to hold a subassembly including a first electronic component having an encapsulant formed thereon" (see claim 1, lines 6-10) and other limitations associated with the subassemblies are functionally intended use, which do not further limit the claimed structure. Moreover, it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

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capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967). In this case, Kuno et al meet every aspect structure limitations of the present invention as shown in the Figs. 1-3 of Kuno et al reference.

Regarding limitation of claim 2, Kuno et al disclose the mold half are move from the first to the second position (see Figs. 1-2, the molds are move from open to close position which read on the claimed the first and the second position). Further, claim 2 recites the excess encapsulant is at least partial served . . . " is functionally intended use which does not further limit the claimed structure.

As applied to claims 3-5, Kuno et al disclose a surface of the mold half having a recess being shaped to receive at least a portion of the assembly 14 (subassemblies) as recited in claim 3; and the volumes (see Figs. 1-2, shows a cavities 5, 6 (= volumes) as recited in claim 4; and the cavities 5, 6 (=volumes) are being adjacent to one another (see Fig. 2).

Regarding limitations of claims 6-7, recites the excess encapsulant includes a cull and a runner and that as recited in claim 7 are related to the encapsulant operation process and appear not further limit the claimed structure.

Limitations of claims 8-12 and 14 are also met by Kuno et al (see illustrated of Figs. 1-2).

***Allowable Subject Matter***

10. Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art taken alone or in combination with other references do not teach the particular hinge assembly 31securing the first half 22 to the retainer 48 the hinge assembly having an axis wherein the first half can pivot about the axis 86 and relative to the retainer as set forth in claim 13 of the present claims.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The teachings of prior art of molding machine for injection molding of an electronic assembly.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Examiner Group 3700